

## REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

Claims 10 and 27 are amended to specify that the electrodeposition paint is an anionic or cationic paint. Support for the amendment is found in the specification at page 9, lines 5-6.

Claim 27 has been withdrawn from consideration as being directed to a non-elected invention by original presentation.

Upon an allowance of the elected product claims 10-26, rejoinder of claim 27 is proper and is respectfully requested. See MPEP 821.04.

Claims 10-11, 13, 15, 17 and 19-26 were rejected under 35 USC 102 as being anticipated by Luch. This ground of rejection is respectfully traversed.

Luch (U.S. Patent 4,101,385) teaches what is mentioned in the Official Action, page 3, line 9 from the bottom, to page 4, line 2.

The present invention and Luch '385 have, in common, a technique of adhering or pressing a conductive plastic film or sheet on the surface of a metal plate. In the present invention, however, an electrodeposition resin coating film is formed on the surface of the plastic, while, in Luch '385, the plastic surface is metal plated, and, in this regard, the two inventions are definitely different.

The Examiner states, "Luch also teaches that the platable (conductive) plastic surface is then plated with electrodeposited paint..." What is used in Luch '385 is not electrodeposition paint, but a nickel plating bath (see column 2, lines 13 and 49), which is clearly distinguished from an anionic or cationic electrodeposition paint in the present invention.

A nickel plating bath is prepared simply by dissolving water-soluble nickel compound in water, and is therefore essentially different from an electrodeposition

paint in the present invention, which mainly comprises a combination of anionizable or cationizable basic resin and crosslinking agent. See page 9, line 4 to page 12, line 4 of the specification.

In the present invention, an electrodeposition coating film which is formed on the surface of conductive plastic film which, in turn, has been adhered to the surface of a metal plate comprises a resin for electrodeposition paint as a main component. In Luch '385, on the other hand, the plate film which is applied on the surface of plastic of a composite structure which comprises aluminum and plastic sheet is a thin film of metal such as nickel. Thus, the electrodeposition coating film in the present invention and the plate film in Luch '385 are compositionally quite different.

Owing to the above-mentioned difference, the coated metal plate of the present invention is superior to Luch '385 in technical effects such as:

- (1) excellent impact resistance and bending resistance; and
- (2) good adhesivity with a coating film, such as top coating film, which is to be further applied on the electrodeposition film.

It would have been impossible to expect the above-mentioned technical advantages of the present invention from the teachings of Luch '385.

Accordingly, Luch '385 fails to disclose each material element of the rejected claims, hence the rejection should be withdrawn.

Claims 10, 15 and 22-26 were rejected under 35 USC 102 as being anticipated by Lo. This ground of rejection is respectfully traversed.

Lo (U.S. Patent 4,740,012) disclose what is mentioned in the Official Action, page 4, line 10 from the bottom, to page 5, line 2.

In Lo, as the Examiner admits, it is not a preformed conductive plastic film or sheet but "an electroconductive primer" (i.e. paint) that is applied on to a non-conductive polymeric component or substrate.

Lo teaches or suggests nothing about the idea of adhering or pressing a preformed conductive plastic film or sheet on to a metal plate.

The technique which is disclosed in Lo corresponds to the prior art which the present invention intends to improve. Lo teaches or suggests nothing about the objective of the present invention and means to attain the objection.

It is therefore clear that the coated metal plate of the rejected claims is not disclosed by Lo. Hence the rejection should be withdrawn.

The Examiner has rejected claims 11, 12, 19 and 20 on the grounds that the subject matter of these claims is obvious over Luch '385.

As the Examiner admits, however, Luch '385 teaches neither the thickness of plastic film which is specified in claims 11 and 12 of the present application nor the thickness of electrodeposition paint film specified in claims 19 and 20 of the same.

Since the invention which is defined in claim 10 of the present application is neither anticipated by, nor obvious over, Luch '385, for the reasons stated above, this ground of rejection is untenable and should be withdrawn.

The Examiner has rejected claims 14 and 16 on the grounds that the subject matter of these claims is obvious over Luch '385 in view of Luch (U.S. Patent 3,865,699) or Luch (U.S. Patent 4,009,093).

Luch '699 and Luch '093 disclose an idea of coating the surface of a non-conductive substrate such as plastic with a mixture of polymer and carbon black, then plating the surface of resultant coating film with metal such as nickel and cobalt, and thus metallizing a non-conductive substrate.

These references, however, teach or suggest nothing about an idea of adhering or pressing a conductive plastic film or sheet on the surface of metal plate, and then coating the surface of said plastic film or sheet with an electrodeposition paint.

Hence, it would have been impossible to achieve the present invention even though the teaching of Luch '699 and Luch '093 had been combined with Luch '385.

Such being the case, the subject matter of claims 14 and 16 is unobvious and patentable over Luch '385 in view of Luch '699 and Luch '093.

The Examiner has rejected claim 18 on the grounds that the subject matter of this claim is obvious over Luch '385 in view of the admitted prior art or Midogohchi et al. (U.S. Patent 5,483,012) or Horibe et al. (U.S. Patent 6,231,984).

Applicant does not deny at all that the electrodeposition paint *per se* which is specified in claim 18 was known.

However, neither Midogohchi et al. nor Horibe et al. teach or suggest an idea of adhering or pressing a conductive plastic film or sheet on the surface of metal plate, and then coating the surface of said plastic film or sheet with the electrodeposition paint.

Such being the case, the subject matter of claim 18 is unobvious and patentable over Luch '385 in view of the admitted prior art or Midogohchi et al. or Horibe et al.

The Examiner has rejected claims 11, 12, 14, 16, 19 and 20 on the grounds that the subject matter of these claims is obvious over Lo in further view of Luch '699, Luch '093 or Palaika et al., in the Official Action, item 12.

Palaika et al. was cited in the previous Official Action, and our comments on this reference is as stated in the Applicant's response filed on March 11, 2002.

Furthermore, it is as stated above that Lo, Luch '699, Luch '093 neither teach nor suggest the features and technical effects of the present invention.

It is clear therefore that the subject matter of claims 11, 12, 14, 16, 19 and 20 was unobvious and patentable over Lo in further view of Luch '699, Luch '093 or Palaika et al.

For the same reason as mentioned above, it is also clear that claims 17 and 18 and claim 21 were not obvious over the references which are cited in the Official Action, items 13 and 14, respectively.

In summary, the cited references individually and in combination do not disclose or suggest the coated metal plate according to claim 10, and the claims dependent thereon. According to claim 10, the coated metal plate comprises:

- (1) a metal plate,
- (2) a conductive plastic film or sheet, and
- (3) an electrodeposition film,
- (4) which is produced by adhering or pressing a preformed conductive plastic film or sheet on a surface of the metal plate, and then
- (5) electrodepositing an anionic or cationic electrodeposition paint on the plastic film or sheet, to form the electrodeposition film.

Claim 10 is solely rejected under 35 USC 102 as being anticipated by Luchs or Lo. Claim 10 is not rejected under 35 USC 103.

Luch is irrelevant to the claimed invention. Luch teaches forming an electrodeposition nickel metal film on a conductive plastic film or sheet.

Thus, Luch fails to disclose or suggest elements (3) and (5) of claim 10 as described above. The electrodeposition film of Luch is a metal film. In contrast, the electrodeposition film of the claimed invention is an electrodeposition paint containing a resin as a main component.

Luch accordingly do not disclose the above features (3) and (5) according to Claim 10 of the present invention.

Nor does Lo disclose the claimed invention of claim 10. Lo is directed to the prior art which the present invention has a main objective of improving. Lo teaches

forming a conductive layer by coating the substrate with an electroconductive primer paint and curing it into a film.

In contrast, the claimed invention involves adhering or pressing a preformed conductive plastic film or sheet on the surface of the metal substrate.

Lo thus fails to disclose the above features (2) and (4) according to claim 10 of the claimed invention.

Since there is no proper rejection of independent claim 10, all other grounds of rejection applied to the dependent claims are untenable and should be withdrawn.

Moreover, the deficiencies of Luch and Lo are not remedied by the teachings of the secondary references cited by the Examiner, namely Luch '699, Luch '093, Midogohchi et al., Horibe et al., or Palaika et al.

The 103 rejections are untenable, because they fail to establish a proper *prima facie* case of obviousness of the claimed invention.

The mere fact that references can be combined or modified does not render the resultant combination obvious, unless the prior art also suggests the desirability of the combination.

A *prima facie* case of obviousness is not created by picking and choosing isolated teachings from the prior art, and then combining those teachings in a mere conclusion that the combination would have been obvious to one of ordinary skill in the art. The burden is on the Examiner to show that the references expressly or impliedly suggest the claimed invention. Alternatively, the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

The teaching or suggestion to make the claimed combinations must be found in the prior art, not in the Applicants' disclosure. Attention is directed to MPEP 2142-2144.

Since the cited references to Luch and Lo fail to disclose the coated metal plate according to claim 10, the sole grounds of rejection of claim 10 set forth in items 7 and 8 are untenable and should be withdrawn.

The remaining rejections of the dependent claims set forth in items 9-14 must thus be withdrawn, since all rejections of the base claim are untenable and must be withdrawn.

Furthermore, there is no proper *prima facie* case of obviousness established of the claims rejected under 35 USC 103 set forth in items 9-14.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached sheets are captioned "Version with markings to show changes made."

In view of the foregoing, it is believed that each ground of rejection is untenable and should be withdrawn.

Accordingly, favorable reconsideration and allowance is respectfully solicited.

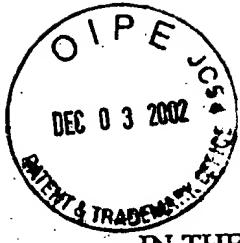
Respectfully submitted,

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Version with Markings to  
Show Changes Made

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Tadashi WATANABE et al. : Docket No.00202/K-210(Kanpe)/YE

Serial No. 09/466,724 : Group Art Unit 1773

Filed December 17, 1999 : Examiner M. Jackson

COATED METAL PLATE

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AMENDMENT

Assistant Commissioner for Patents,  
Washington, D.C.

Sir:

Responsive to the Official Action dated September 11, 2001, the time for responding thereto being extended for three months in accordance with a petition for extension submitted concurrently herewith, please amend the above-identified application as follows:

IN THE CLAIMS

Cancel without prejudice claims 1-9.

Please add the following new claims:

*Annotated*  
10. (New) A coated metal plate, comprising a metal plate, a conductive plastic film or sheet, and an electrodeposition film, which is produced by adhering or pressing a preformed conductive plastic film or sheet on a surface of the metal plate, and then electrodepositing an *anionic* or *cationic* electrodeposition paint on the plastic film or sheet to form the electrodeposition film.

11. (New) The coated metal plate according to claim 10, wherein the plastic film or sheet has a thickness in a range of 1 to 100 µm.

21. (New) The coated metal plate according to claim 10, wherein the plastic film or sheet is adhered to the metal plate using an adhesive.

22. (New) A coated metal plate, comprising a metal plate, a preformed conductive plastic film or sheet, and an electrodeposition film.

23. (New) A car body, comprising the coated metal plate according to claim 10.

24. (New) A car body, comprising the coated metal plate according to claim 22.

25. (New) An article of manufacture, comprising the coated metal plate according to claim 10.

26. (New) An article of manufacture, comprising the coated metal plate according to claim 22.

*Annotated*

27. (New) A method for manufacturing a coated metal plate, which comprises adhering or pressing a preformed conductive plastic film or sheet on a surface of a metal plate, and then electrodepositing an electrodeposition paint on the plastic film or sheet to form an electrodeposition film.